

### **Remarks and Arguments**

Applicants have carefully considered the Office Action dated May 31, 2006 and the reference cited therein. Applicants respectfully request reexamination and reconsideration of the application.

Claim 17 has been amended to correct a punctuation error. This amendment has not been made to distinguish over any reference of record or for patentability purposes to comply with 35 USC 112. Accordingly, no narrowing of any corresponding equivalents to which this claim is entitled is intended by this amendment.

Claim 14 is rejected as being directed to non-statutory subject matter. The Examiner contends that the use of the term "transmission" would not appear to be any of: interconnected mechanical and/or electromechanical components which cooperate to accomplish some function so as to constitute a machine; a tangible, physical article or object which enables the functionality of the instructions to be realized so as to constitute a manufacture; a series of steps or acts so as to constitute a process; nor a combination of two or more substances so as to constitute a composition of matter. In response, applicants have amended the preambles of claims 14-16 to specifically recite a "computer-readable data signal". Applicants respectfully request that the Examiner hold the rejection under 35 U.S.C. 101 in abeyance until a ruling in *In re Petrus ACM Nuijten*, CAFC docket No. 06-1371, U.S. Patent Application Serial No. 09/211,928, regarding the patentability of electrical signals and data embedded therein.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard et al., U.S. Publication No. 2002/0046109, hereinafter Leonard, in view of Welch et al., U.S. Publication No. 2004/0098246, hereinafter Welch.

Applicants respectfully traverse the rejection of claims 1-20 under 35 U.S.C. §103(a) on the grounds that the Examiner has failed to create a *prima facie* case of obviousness. In accordance with MPEP §2143.03, to establish a *prima facie* case of obviousness 1) the prior art reference (or references when combined) must teach or suggest *all* of the claim limitations. In setting forth the rejection, the Examiner has admitted that Leonard does not teach the limitation of associating executable instructions with a custom tag or inserting instructions into a document at a location of the custom tag. Instead, the Examiner is relying on Welch to disclose such teachings.

However, after reviewing Welch, including the sections and figures cited by Examiner, Applicants respectfully disagree with Examiner's conclusion. Specifically, Welch discloses the *extraction* of functional code, such as a JavaScript, from between a pair of special tags in a base document (Welch, page 2, paragraph 19). Conversely, the subject invention claims the *insertion* of instructions into a document at the location of a custom tag. Specifically, claim 6 recites a method for creating a markup language document including the step of "said receiving computer identifying said custom tag and *inserting* said machine-executable instructions into said document at a location associated said custom tag" (claim 6, lines 6-8; *emphasis* added). Claim 14 similarly recites "machine-executable instructions...to *insert* functional executable instructions into said document at a location associated with said custom tag, said functional instructions for performing an operation on said receiving computer" (claim 14, lines 9-12; *emphasis* added). Claim 17 similarly recites "instructions for instructing said processor to *insert* said function-executable instructions into said document at a location associated with said custom tag" (claim 17, lines 9-10; *emphasis* added). In addition, claim 1 has been amended to include the limitations of claim 3 and now recites language similar to the other independent claims including "*inserting* executable instructions into said document at a location of said custom tag, if said custom tag is present" (claim 1, lines 6-7; *emphasis* added). Claim 3 has been canceled without prejudice. Similarly, claim 12 has been amended to include the limitations of claim 13 and now recites language similar to the other independent claims including "*inserting* said function-executable instructions into said document at a location associated with at least one member of said first subset" (claim 12, lines 10-12; *emphasis* added). Claim 13 has been canceled without prejudice.

The Examiner has not shown where the combined teachings of Leonard and Welch teach or suggest *inserting* machine-executable instructions into a document at a location associated with a custom tag. Surely, the Examiner can appreciate the distinction between *extracting* functional code associated with a custom tag and *inserting* machine-executable instructions at the location custom tag, particularly where the instructions are from a system other than one sending the base document. Accordingly, applicants respectfully assert that claims 1, 6, 12, 14 and 17, as well as

their respective dependants claims, patently distinguish over the teachings of Leonard and Welch, whether considered alone or in combination with each other or any other reference of record.

Applicant believes the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he/she is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. DA-12-2158.

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